(6)

No. 04-32

Supreme Court, U.S.
FILED
SEP 27 2004
OFFICE OF THE CLERK

In The

Supreme Court of the United States

MEDRAD, INC.,

Petitioner,

v.

LIEBEL-FLARSHEIM COMPANY
and MALLINCKRODT, INC.,

Respondents.

On Petition For Writ Of Certiorari To The United States Court Of Appeals For The Federal Circuit

SUPPLEMENTAL BRIEF RELATING TO NEW AUTHORITY IN SUPPORT OF PETITION FOR WRIT OF CERTIORARI

W. THOMAS MCGOUGH, JR.
Counsel of Record
FREDERICK H. COLEN
BARRY J. COYNE
REED SMITH LLP
435 Sixth Avenue
Pittsburgh, PA 15219
(412) 288-3131

GREGORY L. BRADLEY
MEDRAD, INC.
One Medrad Drive
Indianola, PA 15051
(412) 767-2400
Attorneys for Petitioner Medrad, Inc.

COCKLE LAW BRIEF PRINTING CO (800) 225-6964
OR CALL COLLECT (402) 342-2831

SUPPLEMENTAL BRIEF

Pursuant to Supreme Court Rule 15.8, Petitioner Medrad, Inc. respectfully submits the following new authority in support of its Petition for Certiorari. Attached as an appendix (App. 170-95) to this submission is the amicus brief of the United States, represented by the United States Patent and Trademark Office, the Department of Justice and the Federal Trade Commission, filed in *Phillips v. AWH Corp. et al.*, Fed. Cir. Appeal Nos. 03-1269, -1286, an *en banc* proceeding in the Federal Circuit. This brief was not available to Medrad at the time of its last brief filed in this Court. *See* Sup. Ct. R. 15.8.

The parallels between the claim construction issues raised in *Phillips* and those raised in Medrad's certiorari petition previously have been noted in Medrad's Supplemental Brief Relating To New Developments In The Federal Circuit In Support Of Petition For Writ Of Certiorari filed in this Court on August 5, 2004. Of particular note, Medrad emphasized why the overlap between these respective cases supported either: (1) a grant of Medrad's petition with a remand to the Federal Circuit for decision in light of the result in *Phillips*; or (2) a grant of Medrad's petition and stay of the proceedings in this Court pending resolution in *Phillips*.

The attached amicus brief filed by the United States supports Medrad's views on the nature and significance of the disputed claim construction issues, the correct methodology for construing patent claims, and underscores the propriety of the specific relief Medrad seeks in this Court. (App. 170-95). The United States' amicus brief makes clear why the result reached by the Federal Circuit in this case is erroneous and warrants further appellate review. The

brief also highlights that important governmental interests are at stake in this proceeding and the views of the federal government align with a grant of certiorari in this case.

Medrad accordingly submits the attached amicus brief of the United States in support of the relief requested in Medrad's Petition for Certiorari and Supplemental Brief filed with this Court.

DATED: September 27, 2004

Respectfully submitted,

W. THOMAS MCGOUGH, JR.
Counsel of Record
FREDERICK H. COLEN
BARRY J. COYNE
REED SMITH LLP
435 Sixth Avenue
Pittsburgh, PA 15219
(412) 288-3131

GREGORY L. BRADLEY
MEDRAD, INC.
One Medrad Drive
Indianola, PA 15051
(412) 767-2400

Attorneys for Petitioner Medrad, Inc.

BRIEF FOR THE UNITED STATES AS *AMICUS CURIAE*

United States Court of Appeals
For the Federal Circuit

Appeal Nos. 03-1269, -1286

EDWARD H. PHILLIPS
Plaintiff-Appellant
v.
AWH CORPORATION, HOPEMAN BROTHERS, INC. AND LOFTON CORPORATION
Defendants-Cross Appellants

Appeal from the United States District Court for the District of Colorado, Case No. 97-MK-212 (CBS)
Judge Marcia S. Krieger

PETER D. KEISLER
ASSISTANT ATTORNEY GENERAL
JOHN J. FARGO
ANTHONY J. STEINMEYER
CIVIL DIVISION
DEPARTMENT OF JUSTICE
WASHINGTON, D.C. 20530

WILLIAM E. KOVACIC
GENERAL COUNSEL
SUZANNE T. MICHEL
CHIEF COUNSEL FOR INTELLECTUAL PROPERTY
FEDERAL TRADE COMMISSION
WASHINGTON, D.C. 20580

JAMES A. TOUPIN
GENERAL COUNSEL

JOHN M. WHEALAN
SOLICITOR

CYNTHIA C. LYNCH
LINDA MONCYS ISACSON
THOMAS W. KRAUSE
ASSOCIATE SOLICITORS

UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 15667
ARLINGTON, VIRGINIA 22215
(703) 305-9035

September 20, 2004

TABLE OF CONTENTS

INTRODUCTION 1

STATEMENT OF INTEREST 2

ISSUES PRESENTED 2

ARGUMENT 3

I. Introduction and Background – Overview of Claim Construction Precedent and Policy 3

A. *Markman* and *Cybor:* Claim Interpretation as a Legal Issue Subject to *De Novo* Review 4

B. *Vitronics:* Preferred Claim Construction Evidence and Methodology 4

C. *Texas Digital:* Heightened Reliance on Dictionaries 5

D. Post-Texas *Digital:* The Current, Conflicting State of the Law on Claim Construction 6

II. Claim Construction Should Start with the Intrinsic Evidence 9

A. Intrinsic Evidence 9

B. Extrinsic Evidence, Including Dictionaries 13

C. Other Doctrines Which Assist in Arriving at and Confirming the Proper Construction of a Claim Term 15

III. The Tension Between Proper Use of the Specification and Improper Reading in of Limitations 17

IV. Deference 21

CONCLUSION 24

TABLE OF AUTHORITIES

CASES

AFG Industries, Inc. v. Cardinal IG Co., Inc., 375 F.3d 1367 (Fed. Cir. 2004) 22

Alloc. Inc. v. I.T.C., 342 F.3d 1361 (Fed. Cir. 2003).. 15, 19, 20

ALTX, Inc. v. United States, 370 F.3d 1108 (Fed. Cir. 2004) 23

Am. Academy of Sciences, In re, 367 F.3d 1359 (Fed. Cir. 2004) 10

Anchor Wall Systems, Inc. v. Rockwood Retaining Walls, Inc., 340 F.3d 1298 (Fed. Cir. 2003) 8

Athletic Alternatives, Inc. v. Prince Mfg., Inc., 73 F.3d 1573 (Fed. Cir. 1996) 17

Bell Atlantic Network Services, Inc. v. Covad Communications Group, 262 F.3d 1258 (Fed. Cir. 2001) 13

Bigio, In re, No. 03-1338, ___ F.3d ___ (Fed. Cir. 2004) 10

Brookhill-Wilk 1, LLC v. Intuitive Surgical, Inc., 334 F.3d 1294 (Fed. Cir. 2003) 13

Cybor Corp. v. FAS Technologies, Inc., 138 F.3d 1448 (Fed. Cir. 1998) (*en banc*)..... 4, 21-23

Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., Ltd., 535 U.S. 722 (2002) 7

Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., Ltd., 344 F.3d 1359 (Fed. Cir. 2003) (*en banc*)..... 7

Generation II Orthotics Inc. v. Med. Tech. Inc., 263 F.3d 1356 (Fed. Cir. 2001) 16-17

Hormone Research Foundation, Inc. v. Genentech, Inc., 904 F.2d 1558 (Fed. Cir. 1990) 16

Intellectual Property Dev., Inc. v. UA-Columbia Cablevision of Westchester, Inc., 336 F.3d 1308 (Fed. Cir. 2003) 7

Int'l Rectifier Corp. v. IXYS Corp., 361 F.3d 1363 (Fed. Cir. 2004) 7

J.T. Eaton & Co. v. Atl. Paste & Glue Co., 106 F.3d 1563 (Fed. Cir. 1997) 17

Liebel-Flarsheim Co. v. Medrad, Inc., 358 F.3d 898 (Fed. Cir. 2004) 16, 18, 19

Markman v. Westview Instruments, Inc., 517 U.S. 370 (1996) 4, 15

Markman v. Westview Instruments, Inc., 52 F.3d 967 (Fed. Cir. 1995) (*en banc*) 4, 14, 15, 18

Merrill v. Yeomans, 94 U.S. 568 (1876) 3

Microsoft Corp. v. Multi-Tech Systems, Inc., 357 F.3d 1340 (Fed. Cir. 2004) 14

Morris, In re, 127 F.3d 1048 (Fed. Cir. 1997) 10

Novartis Pharmaceuticals Corp v. Abbott Labs., 375 F.3d 1328 (Fed. Cir. 2004) 12

Novartis Pharmaceuticals Corp. v. Eon Labs Mfg., 363 F.3d 1306 (Fed. Cir. 2004) 8

Nystrom v. Trex Co., 374 F.3d 1105 (Fed. Cir. 2004) 7, 8

Ornelas v. United States, 374 U.S. 690 (1996) 21

SciMed Life Systems, Inc. v. Advanced Cardiovascular Systems, Inc., 242 F.3d 1337 (Fed. Cir. 2000) 19

SRI Int'l v. Matsushita Elec. Corp., 775 F.2d 1107 (Fed. Cir. 1985) (*en banc*) 16

Sunrace Roots Enter. Co. v. SRAM Corp., 336 F.3d 1297 (Fed. Cir. 2003) 20

Superguide Corp. v. DirectTV Ent., 358 F.3d 870 (Fed. Cir. 2004) 22

Tate Access Floors. Inc. v. Interface Architectural, 279 F.3d 1357 (Fed. Cir. 2002) 18

Texas Digital Systems, Inc. v. Telegenix, Inc., 308 F.3d 1193 (Fed. Cir. 2002) 5, 6, 18, 22

TI Group Automotive Systems, Inc. v. VDO North America LLC, 375 F.3d 1126 (Fed. Cir. 2004) 8

Toro Co. v. White Consolidated Indus., 199 F.3d 1295 (Fed. Cir. 1999) 19-20

United States v. Adams, 383 U.S. 39 (1966) 9

Vanderlande Ind. v. ITC, 366 F.3d 1311 (Fed. Cir. 2004) 12, 15

Vitronics v. Conceptronic, Inc., 90 F.3d 1576 (Fed. Cir. 1996) 4, 5, 10

Wang Labs. v. America Online, Inc., 197 F.3d 1377 (Fed. Cir. 1999) 19

Warner-Jenkinson Co., Inc. v. Hilton Davis Chemical Co., 520 U.S. 17 (1997) 11-12

White v. Dunbar, 119 U.S. 47 (1886) 11

Zletz, In re, 893 F.2d 319 (Fed. Cir. 1989) 10

STATUTES AND REGULATIONS

35 U.S.C. § 282 16

37 C.F.R. § 1.175(d)(1) 11

OTHER AUTHORITIES

Joseph Scott Miller & James A. Hilsenteger, The Proven Key: Roles and Rules for Dictionaries at the Patent Office and the Courts, (unpublished manuscript, available at http://papers.ssrn.com/sol3/papers.cfm?abstract_id=577262) 22

R. Polk Wagner & Lee Petherbridge, Is the Federal Circuit Succeeding? An Empirical Assessment of Judicial Performance, 152 U. Pa. L. Rev. 1105 (2004) ... 21-22

BRIEF FOR THE UNITED STATES AS *AMICUS CURIAE*

United States Court of Appeals
For the Federal Circuit

Appeal Nos. 03-1269, -1286

EDWARD H. PHILLIPS
Plaintiff-Appellant
v.
AWH CORPORATION, HOPEMAN BROTHERS, INC. AND LOFTON CORPORATION
Defendants-Cross Appellants

Appeal from the United States District Court for the District of Colorado, Case No. 97-MK-212 (CBS)
Judge Marcia S. Krieger

INTRODUCTION

In response to the July 21, 2004 Order from the Court, the United States Patent and Trademark Office

("USPTO"), with the support of United States Department of Justice ("DOJ") and the Federal Trade Commission ("FTC"), respectfully submits this *amicus curiae* brief. See also Fed. R. App. P. 29.

STATEMENT OF INTEREST

The United States' strong interest in a fair, stable, predictable, and efficient patent system embraces a number of perspectives, including: (i) the USPTO's responsibility for examining all patent applications, and construing the claims therein; (ii) DOJ's and the FTC's interest in advancing consumer welfare through enforcement of competition laws and advocacy on competition-related issues; (iii) as a patent holder; and (iv) as a defendant in patent infringement actions.

ISSUES PRESENTED

The Court's July 21, 2004 Order sets out seven questions. They generally fall under three broad categories: (1) how and to what extent various types of evidence, particularly the specification and dictionaries, should be relied on for claim construction; (2) how the specification should properly be used to interpret claims without impermissibly importing limitations into the claims; and (3) what deference, if any, this Court should give a district court's claim construction.[1]

---

[1] The government takes no position on the specific facts of this case.

ARGUMENT

I. *Introduction and Background* – *Overview of* Claim Construction Precedent and Policy

Claim construction necessitates balancing the public notice function of patents with the sometimes competing policy of a fair scope of protection for patentees. As the Supreme Court noted, "[i]t seems to us that nothing can be more just and fair, both to the patentee and to the public, than that the former should understand, and correctly describe, just what he has invented, and for what he claims a patent." *Merrill v. Yeomans*, 94 U.S. 568, 573-74 (1876).

Ideally, the patentee's correct description of the invention should be clearly reflected in the claims. Yet patent infringement and invalidity cases routinely involve disputes over the meaning of claim language. Principles of claim construction that stress the understanding of persons of ordinary skill in the art facilitate equitable treatment of patentees and the public, and should produce predictability in claim interpretation.

A. *Markman* and *Cybor*: Claim Interpretation as a Legal Issue Subject to *De Novo* Review

Markman v. Westview Instruments, Inc., 517 U.S. 370 (1996) affirmed this Court's *en banc* holding that no jury right exists for claim interpretation. *See Markman v. Westview Instruments, Inc.*, 52 F.3d 967 (Fed. Cir. 1995) (*en banc*). Subsequently, *Cybor Corp. v. FAS Technologies, Inc.*, 138 F.3d 1448 (Fed. Cir. 1998) (*en banc*) held that the meaning of any given word in a claim constitutes a pure question of law, reviewed *de novo* on appeal. However, five concurring and dissenting judges stated that some form of

deference should be given to the district courts' claim interpretation. *Id.*

B. *Vitronics:* Preferred Claim Construction Evidence and Methodology

This Court provided significant guidance on claim construction methodology in *Vitronics v. Conceptronic, Inc.*, 90 F.3d 1576 (Fed. Cir. 1996). Giving primacy to intrinsic evidence of record (the claims, specification, prosecution history and cited prior art) over extrinsic evidence (*e.g.*, expert testimony, treatises, dictionaries), the Court deemed it improper to rely on extrinsic evidence if the intrinsic evidence provided sufficient clarity. *Id.* at 1582-83. However, in the event of an ambiguity, extrinsic evidence may be permitted "to help the court come to the proper understanding of the claim term," but not to contradict intrinsic evidence or to vary the scope of the claims. *Id.* at 1584. Also *Vitronics* noted that among the types of extrinsic evidence, "prior art documents and dictionaries, although to a lesser extent, are more objective and reliable guides" than expert testimony, which tends to be biased. *Id.* at 1585.

C. *Texas Digital:* Heightened Reliance on Dictionaries

Texas Digital Systems. Inc. v. Telegenix, Inc., 308 F.3d 1193 (Fed. Cir. 2002) seemed to contradict some of the holdings of *Vitronics*, and elevated the importance of dictionaries. The *Texas Digital* court opined that routinely looking to dictionary definitions first, as the baseline for a claim construction analysis, would help avoid improper importation of limitations from the specification and

further the goal of giving claim terms their "ordinary and customary" meaning. *Id.* at 1202. In particular, the decision stated that dictionaries and treatises "may be the *most meaningful* sources of information to aid judges in better understanding both the technology and the terminology used by those skilled in the art to describe the technology." *Id.* at 1203 (emphasis added).

Texas Digital suggested starting with dictionaries, and then looking to the intrinsic record only to determine whether the dictionary definition is rebutted. *Id.* at 1204. The Court indicated that dictionary evidence establishes a "heavy presumption," requiring a court to give the term "the full range of its ordinary meaning" according to the dictionary, unless "compelled otherwise." *Id.* at 1203. According to *Texas Digital*, a court may depart from the dictionary definition in two limited circumstances: (i) lexicography, when the specification sets forth an explicit definition of the term different from its ordinary meaning, or (ii) disclaimer, when the specification "us[es] words or expressions of *manifest exclusion or restriction*, representing a clear disavowal of claim scope." *Id.* at 1204 (emphasis added). However, this Court's recent precedent reflects that these two circumstances, where the specification explicitly "trumps" the dictionary, rarely arise.

D. Post-Texas *Digital:* The Current, Conflicting State of the Law on Claim Construction

Texas Digital set the stage for a much more ubiquitous and prominent role for dictionaries in claim construction, in the hope that the objectivity of dictionary definitions would alleviate many of the difficulties with claim construction. However, this laudable goal has not been realized.

Litigants have converted claim construction disputes into a "battle of the dictionaries." The increased reliance on dictionary definitions as a foundation for claim meaning has generated inconsistent and unpredictable results, and therefore has not improved the state of the law of claim construction. In some instances, beginning with a dictionary definition has resulted in a broadening of claims beyond what the public record likely reflects to a person of ordinary skill in the art. In *Nystrom v. Trex Co.*, 374 F.3d 1105, 1106 (Fed. Cir. 2004), the majority interpreted the term "board" to cover not only wood, but any hard surface, even though, as the dissent noted, it is unclear that the specification would support such a broad definition.[2] In other instances, with multiple dictionaries in play, the Court selected a narrower definition. For example, *Intellectual Property Dev., Inc. v. UA-Columbia Cablevision of Westchester, Inc.*, 336 F.3d 1308, 1315-16 (Fed. Cir. 2003) adopted a more restrictive definition of "high frequency" common to *all* the dictionary sources consulted, and rejected the contention that looking at the dictionary before the intrinsic evidence "put the cart before the horse."

Resorting to different dictionaries from case to case has undermined the clarity and predictability that *Texas Digital* sought, because the uncertainty about which dictionary the Court will use prevents patent applicants from adjusting their expectations around a particular,

---

[2] This desire to give claims a broad literal scope may be the result of the restrictions placed on the availability of the doctrine of equivalents by the recent decision in *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., Ltd.*, 535 U.S. 722 (2002), and on remand, 344 F.3d 1359 (Fed. Cir. 2003) (*en banc*).

designated dictionary. For instance, in *Int'l Rectifier Corp. v. IXYS Corp.*, 361 F.3d 1363 (Fed. Cir. 2004), the district court relied on *Webster's Ninth New Collegiate Dictionary*, but this Court relied instead on *Webster's Third New International Dictionary*, and reversed the district court's construction of one term based on a usage note from *Webster's Third*. In *TI Group Automotive Systems, Inc. v. VDO North America LLC*, 375 F.3d 1126 (Fed. Cir. 2004), this Court relied in part on the *Oxford English Dictionary*, while in *Anchor Wall Systems, Inc. v. Rockwood Retaining Walls, Inc.*, 340 F.3d 1298, 1311 (Fed. Cir. 2003), this Court turned to *Webster's Third*, although the district court had relied on *Merriam-Webster Collegiate Dictionary*.

Moreover, the lack of clarity as to which dictionary to use is further complicated by the lack of clarity as to *which definition within a particular dictionary* to use. *See Nystrom*, 374 F.3d at 1112 (relying on the second of two definitions of "board" found in *The American Heritage Dictionary*). Another growing phenomenon is the use of dictionaries sequentially to define term after term. For example, in *Novartis Pharmaceuticals Corp. v. Eon Labs Mfg.*, 363 F.3d 1306, 1308-10 (Fed. Cir. 2004), the Court divided the term "hydrosol" into its component terms, consulted dictionary entries first for those terms, then again for other terms in the dictionary entries. Thus, even with an established approach of turning first to dictionary evidence, the interested parties cannot anticipate which sources or definitions will determine claim meaning, or which terms within a definition the court might decide require further definition.

More fundamentally, the use of dictionaries as the initial baseline for the meaning of claim language, instead of the intrinsic evidence, runs counter to the long-established

doctrine that claims should be understood in view of the specification as a whole. "[I]t is fundamental that claims are to be construed in the light of the specifications and both are to be read with a view to ascertaining the invention." *United States v. Adams*, 383 U.S. 39, 48-49 (1966). Primary reliance on dictionaries that are not part of the patent's public record subordinates the patentee's own explanation of his invention in favor of a dictionary definition never at issue during the patent prosecution before the USPTO.

II. Claim Construction Should Start with the Intrinsic Evidence

A. Intrinsic Evidence

Our first issue – how and to what extent various types of evidence should be relied on in claim construction – relates to questions (1) through (4) and (6). As *Vitronics* stated, reliance on the intrinsic evidence as the starting point for interpreting claims preserves established doctrines of patent law, does not upset settled expectations, and achieves a reading of patent claims that serves the public notice function of claiming while remaining fair to the patentee. "The specification contains a written description of the invention which must be clear and complete enough to enable those of ordinary skill in the art to make and use it. Thus, the specification is always highly relevant to the claim construction analysis. Usually, it is dispositive; it is the single best guide to the meaning of a disputed term." *Vitronics*, 90 F.3d at 1582 (citations omitted).

Moreover, primary reliance on intrinsic evidence, rather than later-determined dictionaries that were not

part of the record, generates the greatest likelihood that the claim construction will be consistent with the USPTO's interpretation of the claims in issuing the patent.[3] While patent examiners and prosecutors may frequently rely on their own understanding of terms, both technical and non-technical, they rarely, if ever, explicitly rely on dictionary definitions to understand or define claim terms.

Using the dictionary as the premise, and looking to the specification only for rebuttal by lexicography or clear disclaimer/disvowal is a problematic approach. Specifically, the patentee and the USPTO typically focus on the "context" of the invention as reflected in the specification rather than on dictionary evidence. *See White v. Dunbar*, 119 U.S. 47, 51 (1886) ("The context may, undoubtedly, be resorted to, and often is resorted to, for the purpose of better understanding the meaning of the claim"). The

---

[3] The USPTO employs an approach to claim construction somewhat distinct from a district court's approach. *In re Morris*, 127 F.3d 1048, 1054 (Fed. Cir. 1997) (noting USPTO's and courts' different claim construction approaches, in view of their different roles). During prosecution, claims are "given their *broadest reasonable interpretation* consistent with the specification. . . . Giving claims their broadest reasonable construction 'serves the public interest by reducing the possibility that claims, finally allowed, will be given broader scope than is justified.'" *In re Am. Academy of Sciences*, 367 F.3d 1359, 1364 (Fed. Cir. 2004) (emphasis added) (citations omitted); see *also In re Bigio*, No. 03-1338, ___ F.3d ___ (Fed. Cir. 2004). The policy underlying USPTO's "broadest reasonable interpretation" approach stems from the applicant's opportunity during patent prosecution to amend the claims. *See id.*; *In re Zletz*, 893 F.2d 319, 321 (Fed. Cir. 1989).

The USPTO may not have understood the claim term in the broadest sense *possible*, but rather in the broadest *reasonable* sense, informed by the specification, cited prior art and arguments by the applicant. For courts not to give primacy to the context provided by the intrinsic evidence therefore risks interpretation of claims at odds with the USPTO's interpretation in issuing the patent.

USPTO examines applications according to the principle set out in Rule 1.75(d)(1) that "[t]he claim or claims must conform to the invention as set forth in the remainder of the specification and the terms and phrases used in the claims must find clear support or antecedent basis in the description *so that the meaning of the terms in the claims may be ascertainable by reference to the description.*" 37 C.F.R. § 1.175(d)(1) (emphasis added). Use of later-selected extrinsic dictionary evidence "might in some instances unfairly discount the expectations of a patentee who had no notice at the time of patent prosecution that such a presumption would apply" who, "[y]ears after the fact, . . . may find it difficult to establish an evidentiary basis that would overcome the new presumption." *See Warner-Jenkinson Co., Inc. v. Hilton Davis Chemical Co.*, 520 U.S. 17, 41 (1997) (Ginsburg, J., concurring). Given the effort to make the significance of claim terms transparent from the specification, the public and the courts should logically first turn to the specification, which *was* considered during prosecution, to help understand the scope of the claimed invention.

The government maintains that the specification and prosecution history should receive more extensive consideration in claim construction than merely to rebut a dictionary either by lexicography or clear disclaimer, two relatively rare occurrences. The intrinsic evidence, including cited prior art, may indirectly convey the customary meaning of a disputed claim term, or will at least provide additional useful context that should be considered when consulting extrinsic evidence. In such cases, while lexicography does not explicitly define claim terms, " 'the specification may still define [them] 'by implication' such that the meaning may be found or ascertained by a reading of the

patent documents.'" *Novartis Pharmaceuticals Corp v. Abbott Labs.*, 375 F.3d 1328, 1334 (Fed. Cir. 2004) (citations omitted). In *Vanderlande Ind. v. ITC*, 366 F.3d 1311, 1318 (Fed. Cir. 2004), this Court noted that the specification should first be consulted to determine if claim terms are expressly or *impliedly* defined. For example, where a claim term by itself might have several possible ordinary meanings, the specification or prosecution history may indicate the most appropriate definition, by context and implication. This Court has correctly observed that the use of "a claim term throughout the entire patent specification, in a manner consistent with a single meaning" may define that term "by implication." *Bell Atlantic Network Services, Inc. v. Covad Communications Group*, 262 F.3d 1258, 1271 (Fed. Cir. 2001). Thus, in selecting among several possible ordinary meanings, one meaning may be inferred from the patent specification's use of the term throughout in a manner consistent with that particular meaning of the term.

B. Extrinsic Evidence, Including Dictionaries

Claims must be construed from the perspective of one of ordinary skill in the art, and a judge attempts to replicate that perspective in reviewing the intrinsic evidence. *Brookhill-Wilk 1, LLC v. Intuitive Surgical, Inc.*, 334 F.3d 1294, 1298 (Fed. Cir. 2003) ("The words used in the claims are examined through the viewing glass of a person skilled in the art"). Thus, the courts may turn to extrinsic evidence to aid in finding the level of ordinary skill in the art, in understanding the intrinsic evidence, and in discerning the meaning that one skilled in the art would give claim terms when read in the context of the entire specification. A judge may consider extrinsic evidence as to whether a

common term has a special meaning in the relevant field. For a term without a special art-recognized meaning (*e.g.*, "between"), the judge may not need to consult any extrinsic source. Nonetheless, even with such non-technical terms, consultation of dictionaries may play a role in resolving disputes about ordinary meaning of terms not defined by the specification. So, while dictionary evidence does not set the baseline meaning of a claim term, the objectivity of dictionary evidence may provide a useful tool in weighing the parties' contentions as to ordinary meaning.

With technical terms, the person of ordinary skill has an understanding of the art-recognized meaning that the judge may typically lack. Therefore, the judge may reasonably seek to replicate – put on the appropriate "viewing glass" – by consulting extrinsic evidence to aid in the review of the intrinsic evidence. Judges should have discretion to consider extrinsic evidence, including expert testimony and technical dictionaries, when interpreting claims, especially technical terms of art. *See e.g. Microsoft Corp. v. Multi-Tech Systems, Inc.*, 357 F.3d 1340 (Fed. Cir. 2004) (construing "headers" in the computer context).

If considered, the extrinsic evidence, including dictionaries, should always be considered for the purpose of elucidating the intrinsic evidence and not for the purpose of establishing a presumptive meaning of claim terms without reference to the intrinsic evidence. *See Markman*, 52 F.3d at 981; *see also Alloc. Inc. v. I.T.C.*, 342 F.3d 1361 (Fed. Cir. 2003) ("[A] court must resist relying on any of these sources [intrinsic and extrinsic] in a vacuum because they each influence the understanding of one of skill in the art at the time of invention. . . ."). "While extrinsic evidence can shed useful light on the relevant art – and thus

better allow a court to place itself in the shoes of a person of ordinary skill in the art – the 'intrinsic evidence is the most significant source of the legally operative meaning of disputed claim language.'" *Vanderlande*, 366 F.3d at 1318.

The very nature of a patent as a legal document demands that the specification, rather than evidence extrinsic to the patent like dictionaries, serve as the primary source for determining its legal scope. A "patent is a fully integrated written instrument." *Markman*, 52 F.3d at 978. For that reason, claim construction is "a necessarily sophisticated analysis of the whole [patent] document required by the standard construction rule that a term can be defined only in a way that comports with the instrument as a whole." *Markman*, 517 U.S. at 389.

C. Other Doctrines Which Assist in Arriving at and Confirming the Proper Construction of a Claim Term

Where ambiguity remains after the review of the intrinsic evidence, aided by extrinsic evidence where needed, application of other doctrines, such as claim differentiation and construction to preserve validity, become appropriate considerations to aid in determining the meaning a person of ordinary skill in the art would give the claim term. For example, "[i]t is settled law that when a patent claim does not contain a certain limitation and another claim does, that limitation cannot be read into the former claim in determining either validity or infringement." *SRI Int'l v. Matsushita Elec. Corp.*, 775 F.2d 1107, 1122 (Fed. Cir. 1985) (*en banc*). However, reliance on claim differentiation should be reserved for those situations where the review of the intrinsic and extrinsic evidence fails to yield a single clear definition. This prevents claim

differentiation from improperly "overshadow[ing] the express and contrary intentions of the patent draftsman." *See Hormone Research Foundation. Inc. v. Genentech, Inc.*, 904 F.2d 1558 (Fed. Cir. 1990).

Similarly (and in response to this Court's question (5)), in seeking the meaning of a truly ambiguous claim term (perhaps where several different definitions of a term could reasonably apply), competitors and the public should expect such terms to be construed in a manner that sustains the validity of the patent claim. Reliance on this doctrine comports with the statutory presumption of patent validity in 35 U.S.C. § 282. Yet, reliance on the doctrine should be limited to those situations where more than one interpretation is otherwise reasonable, but one interpretation would render the claim invalid. *See Liebel-Flarsheim Co. v. Medrad, Inc.*, 358 F.3d 898, 914 (Fed. Cir. 2004). As this Court noted in *Generation II Orthotics Inc. v. Med. Tech. Inc.*, 263 F.3d 1356, 1365 (Fed. Cir. 2001), "claims can only be construed to preserve their validity where the proposed claim construction is 'practicable,' is based on sound claim construction principles, and does not revise or ignore the explicit language of the claims."

Finally, if a disputed term lacks a customary meaning, and was essentially created by the patentee (but not defined in the specification or prosecution history), its meaning should be derived from the context of the patent, but construed narrowly against the patent drafter, in view of the patentee's failure in his obligation to clearly define the term. *See J.T. Eaton & Co. v. Atl. Paste & Glue Co.*, 106 F.3d 1563, 1568 (Fed. Cir. 1997). As this Court has stated, "[w]here there is an equal choice between a broader and a narrower meaning of a claim, and there is an enabling disclosure that indicates that the applicant is at

least entitled to the narrower meaning, we consider the notice function of the claim to be best served by adopting the narrower meaning." *See Athletic Alternatives, Inc. v. Prince Mfg., Inc.*, 73 F.3d 1573, 1581 (Fed. Cir. 1996).

III. The Tension Between Proper Use of the Specification and Improper Reading in of Limitations

Our second issue – how the specification should properly be used to interpret claims without impermissibly importing limitations into the claims – relates to this Court's question (3). As this Court noted in *Markman*, "[t]he written description part of the specification itself does not delimit the right to exclude. That is the function and purpose of claims." 52 F.3d at 980. The *Texas Digital* court's motivation for advocating starting with dictionaries rather than the intrinsic evidence was the frequent mistake of impermissibly importing limitations from the specification. *See Texas Digital*, 308 F.3d at 1204. Despite the government's recommendation to scale back the use of dictionaries as the baseline for claim meaning, the government, like *Texas Digital*, recognizes that courts conducting claim construction face a great challenge navigating the shoals between properly relying on the specification and going too far and improperly importing limitations from it. "Fairness and the public notice function of the patent law require courts to afford patentees the full breadth of clear claim language, and bind them to it as well." *Tate Access Floors, Inc. v. Interface Architectural*, 279 F.3d 1357, 1367 (Fed. Cir. 2002). Typically, these competing policy concerns form the tension behind a determination whether to limit or broaden a claim term in view of the specification, even where the specification has not explicitly defined the term.

Recently, in *Liebel-Flarsheim*, 358 F.3d at 904, Judge Bryson described the "fine line" between the competing axioms that claims be read in view of the specification, and that limitations not be imported from the specification into the claims. He aptly observed that "[a]lthough parties frequently cite one or the other of these axioms to us as if the axiom were sufficient, standing alone, to resolve the claim construction issues we are called upon to decide, the axioms themselves seldom provide an answer, but instead merely frame the question to be resolved." *Id.*

Additional guidance by this Court on the issue could assist the district courts in resolving this tension. As a general matter, courts should be less inclined to infer a more narrow definition of a disputed claim term from the specification if a person of ordinary skill in the art would consider the feature relied on from the specification "exemplary" or insignificant to the essence or primary purpose of the invention. As this Court in *Alloc* phrased it, the balance between construing in light of the specification and impermissibly importing limitations, "turns on how the specification characterizes the claimed invention." 342 F.3d at 1370. This Court has attempted to interpret claims to encompass a feature that the specification describes as essential to the invention, or that the specification used to distinguish the prior art. For example, in *SciMed Life Systems, Inc. v. Advanced Cardiovascular Systems, Inc.*, 242 F.3d 1337, 1344 (Fed. Cir. 2000) and in *Wang Labs. v. America Online, Inc.*, 197 F.3d 1377, 1384 (Fed. Cir. 1999), this Court held that claims cannot be construed as encompassing prior art that was distinguished in the specification and disclaimed during prosecution. *Toro Co. v. White Consolidated Indus.*, 199 F.3d 1295, 1301 (Fed. Cir. 1999) illustrates a claim interpretation consistent with a feature

emphasized in the specification "as important to the invention."

A merely exemplary feature, because of its *exemplary* status, should not be read into claims whose words do not include that feature. By way of illustration, where the specification describes a feature, not found in the words of the claims, only to fulfill the statutory best mode requirement, the feature should be considered exemplary, and the patentee should not be unfairly penalized by the importation of that feature into the claims. A person of ordinary skill may also consider a feature merely exemplary where "nothing in the written description indicates that the invention is exclusively directed toward" the feature or suggests that embodiments without it are outside the scope of the invention. *Sunrace Roots Enter. Co. v. SRAM Corp.*, 336 F.3d 1297, 1305 (Fed. Cir. 2003). However, if the specification "as a whole suggests that the very character of the invention requires the limitation be a part of every embodiment," then defining a claim term in accordance with that limitation would be appropriate. *Alloc*, 342 F.3d at 1370.

IV. Deference

Our third issue (question (7)) concerns whether this Court owes any deference to district courts' claim construction decisions. Construing *Markman* and adhering to its prior position, this Court held in *Cybor* that claim construction is a matter of law reviewed *de novo* on appeal. *Cybor*, 138 F.3d at 1456. In our view, Judge Bryson correctly articulated that this Court should "approach the legal issue of claim construction recognizing that with respect to certain aspects of the task, the district court

may be better situated than [the Federal Circuit is], and that as to those aspects [this Court] should be cautious about substituting [its] judgment for that of the district court." *Cf.*, *Ornelas v. United States*, 517 U.S. 690, 699 (1996) (holding that reasonable suspicion and probable cause determinations are reviewable *de novo* but that "a reviewing court should take care both to review findings of historical fact only for clear error and to give due weight to inferences drawn from those facts by resident judges and local law enforcement officers"). A district court's consideration of live testimony relating to claim construction comprises one of the few examples where deference is appropriate.

The uncertainty resulting from this Court's high reversal rate on claim construction has generated concern, and has resulted in more claim construction appeals with more terms at issue. *See e.g.* Polk Wagner & Lee Petherbridge, Is the Federal Circuit Succeeding? An Empirical Assessment of Judicial Performance, 152 U. Pa. L. Rev. 1105, 1107 (2004); Joseph Scott Miller & James A. Hilsenteger, The Proven Key: Roles and Rules for Dictionaries at the Patent Office and the Courts, (unpublished manuscript, available at http://papers.ssrn.com/sol3/papers.cfrn?abstract_id=577262) (noting a sharp increase in claim construction appeals post-*Markman*); see *also Cybor*, 138 F.3d at 1476 (Rader, J., dissenting in part) (referring to the Court's "near 50%" reversal rate as "the worst possible"). Not only have the number of appeals on claim construction increased, but many include numerous disputed claim terms. *See e.g. Texas Digital*, 308 F.3d 1193 (nine terms); *Superguide Corp. v. DirectTV Ent.*, 358 F.3d 870 (Fed. Cir. 2004) (ten phrases). Moreover, many of these appeals come from summary judgment rulings, and often the record may

not yet be fully developed. *See e.g. AFG Industries, Inc. v. Cardinal IG Co., Inc.*, 375 F.3d 1367, 1375 (Fed. Cir. 2004) (Newman, J., dissenting) (dissenting from the panel's reversal of summary judgment and remand "for the third time on the issue of claim construction with respect to the claim term 'layer'"). Thus, it is not surprising that in a given case, *de novo* review of the interpretations of the multiple disputed claim terms, typically on a limited record, often yields some ground for reversal.

These problems should be addressed by this Court providing additional guidance on general principles of claim construction. Such additional guidance will likely generate more consistent and well-reasoned district court decisions. Under *de novo* review, a district court's claim construction stands or falls on such persuasiveness. *See Cybor*, 138 F.3d at 1462 (Plager, J., concurring) ("Th[e] weight [given to a trial judge's view] may vary depending on the care, as shown in the record, with which that view was developed, and the information on which it is based").

As this Court has recognized in an analogous context, "our *de novo* posture essentially repeats the Court of International Trade's review [of International Trade Commission determinations] for substantial evidence; however, 'we will not ignore the informed opinion of the Court of International Trade.'" *ALTX, Inc. v. United States*, 370 F.3d 1108, 1116 (Fed. Cir. 2004). A similar approach should be taken with respect to a district court's claim construction, so that rather than starting from a "clean slate," this Court gives due consideration to a persuasive claim construction by the district court and accords due weight to its evaluation of any live testimony on this issue.

CONCLUSION

In summary, to strike the appropriate balance between the public notice function of claiming and fairness to the patentee, the United States advocates the foregoing approach to claim construction and the review thereof.

September 20, 2004

Respectfully submitted,

/s/ John M. Whealan

JAMES A. TOUPIN
GENERAL COUNSEL

JOHN M. WHEALAN
SOLICITOR

CYNTHIA C. LYNCH
LINDA MONCYS ISACSON
THOMAS W. KRAUSE
ASSOCIATE SOLICITORS

UNITED STATES PATENT
AND TRADEMARK OFFICE

PETER D. KEISLER
ASSISTANT ATTORNEY GENERAL
JOHN J. FARGO
ANTHONY J. STEINMEYER
CIVIL DIVISION
DEPARTMENT OF JUSTICE
WASHINGTON, D.C. 20530

WILLIAM E. KOVACIC
GENERAL COUNSEL
SUZANNE T. MICHEL
CHIEF COUNSEL FOR
INTELLECTUAL PROPERTY
FEDERAL TRADE COMMISSION
WASHINGTON, D.C. 20580

RULE 32(a)(7)(c) CERTIFICATE OF COMPLIANCE

I certify pursuant to Fed. R. App. Proc. 32(a)(7) that the foregoing BRIEF OF THE UNITED STATES AS *AMICUS CURIAE* complies with the word limitation. The total number of words in the foregoing brief is 4,996 words as calculated by the Word Perfect word processing program used to prepare the brief.

/s/ Cynthia C. Lynch
Cynthia C. Lynch
Associate Solicitor

CERTIFICATE OF SERVICE

I hereby certify that on September 20, 2004, I caused two copies of the foregoing BRIEF FOR THE UNITED STATES AS *AMICUS CURIAE* to be transmitted via Federal Express, addressed as follows:

Mark W. Fischer
Faegre & Benson
1900 15th Street
Boulder, CO 80302

Carl F. Manthei
Attorney at Law
1205 17th Street
Boulder, CO 80302-6315

/s/ Cynthia C. Lynch
Cynthia C. Lynch
Associate Solicitor
U.S. Patent and
Trademark Office
P.O. Box 15667
Arlington, Virginia 22215
703-305-9035